

## REMARKS

The office action of October 3, 2007, has been carefully reviewed and these remarks are responsive thereto. Reconsideration and allowance of the instant application are respectfully requested. Claims 2-4, 7-8, 12-13, 16-17, 27, 30-35, and 38-41 have been amended to place the claims in a more preferred form. Claim 28 has been canceled without prejudice or disclaimer. Claims 1-21, 27-43, and 46-48 remain pending.

Claims 1-21, 27-43, and 46-48 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Herz et al. (U.S. Pub. App. No. 2001/0014868, hereinafter referred to as *Herz*) in view of Birdwell et al. (U.S. Pat. No. 6,108,706, hereinafter referred to as *Birdwell*). Applicants respectfully traverse.

In order to establish a *prima facie* case of obviousness under § 103(a), three criteria must exist: 1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings; 2) there must be a reasonable expectation of success; and 3) the prior art reference(s) must teach or suggest all the claim limitations. *See* MPEP § 706.02 (j); *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991).

With respect to Applicants' claim 1, even if the references were combined, the combination still would not teach or suggest all the claim features. As admitted by the Action, *Herz* does not "explicitly disclose requesting, via the first network, further information from the computer network, wherein the further information is based on the received identifier; and receiving the further information via one of the first or second network." (Action, p. 3). To support this deficiency of *Herz*, the Action relies on *Birdwell* as describing these features. Yet, as previously admitted on multiple occasions by the Examiner, *Birdwell* fails to teach or suggest these features as well.

network(col.3,lines 63-67 & col.4, lines 1-10. However Birdwell did not explicitly disclose requesting, via the first network, further information from the computer network, wherein the further information is based on the received identifier; and receiving the further information via one of the first or second network.

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10. However *Birdwell* did not explicitly disclose requesting, via the first network, further information from the computer network, wherein the further information is based on the received identifier, and receiving the further information via one of the first or second network.

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These admissions followed an Appeal where prosecution was reopened based upon this admission by the Examiner. However, without having amended these features of Applicants' claim 1, the Action now states that *Birdwell* does teach or suggest these features. As noted in previous responses, the non-final Office Action mailed June 15, 2006, and the final Office Action mailed December 1, 2006, are correct in that *Birdwell* does fail to teach or suggest these features.

*Birdwell* discloses a set of content servers 22, a bidirectional data network 28, a unidirectional broadcast network 30, and a set of clients 24. (Fig. 1; col. 3, lines 10-16; col. 3, lines 23-31). Announcements are submitted by the content servers 22 over the data network 28 to inform the clients 24 of upcoming data transmissions that will be broadcast at a future time over the broadcast network 30. (Col. 5, lines 5-8).

The announcements in *Birdwell* include information such as identification of the sender, URL, channel, frequency, broadcast time, and broadcast protocol; the clients 24 use this information and launch a receiving application 64 to receive the data transmission at the appropriate time. (Col. 1, line 63 to col. 2, line 5; col. 5, lines 15-20 and 40-46). The clients 24 may also use a filter to determine whether announcements meet certain criteria that are of interest. (Col. 5, lines 26-39). The actions taken by the clients 24 are summarized by the flowchart of Fig. 4, which shows that the clients 24 examine an announcement (step 90), determine whether the announcement matches the filter criteria (step 94), and if so, prepare to receive the related broadcast at the scheduled time using the indicated protocol (steps 94 and 96).

Importantly, *Birdwell* describes how the clients 24 do not (and cannot) request the future broadcasts over unidirectional broadcast network 30:

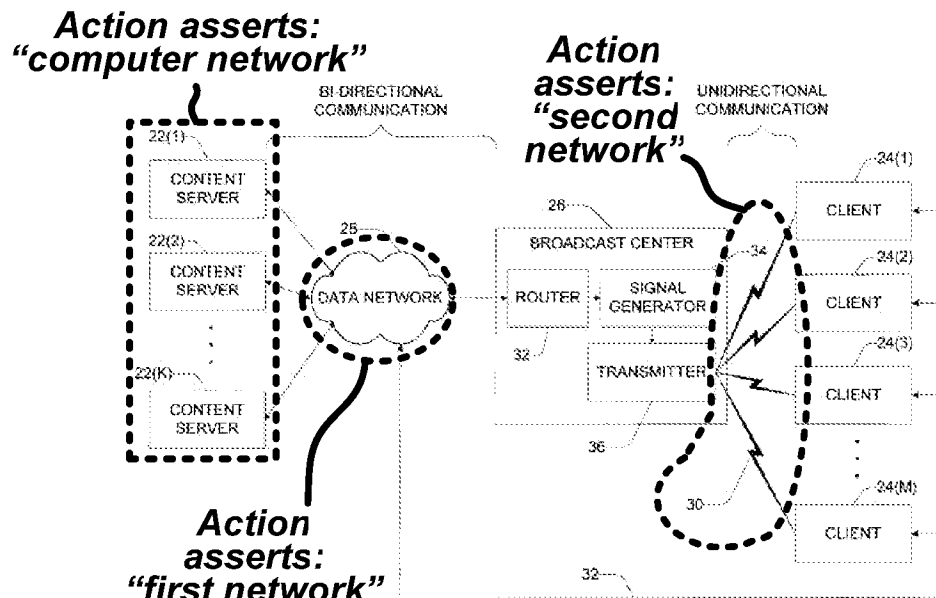
Rather than the clients requesting particular data from the servers, as is customary in conventional data networks but cannot be supported by

unidirectional broadcast networks, the servers tell the clients through the announcements what data will be served over the broadcast network at a given time and how to find that data.

*Birdwell*, col. 5, lines 8-14. Nor does *Birdwell* teach or suggest that the network would respond by providing the future broadcast based on any supposed request by the clients 24. To the contrary, the future broadcast will occur only according to the schedule. Thus, *Birdwell* operates in a manner similar to how one typically programs a VCR to record a television show at a pre-scheduled time; a schedule is broadcast and the VCR is set to record at the scheduled time on the scheduled channel.

In contrast, claim 1 recites “requesting, via a first network, further information from a computer network, wherein the further information is based on a received identifier; and receiving further information via one of the first or second networks.” As summarized above and as will be further explained, the clients 24 of *Birdwell* are strictly passive and do not perform the claimed step of requesting.

The Action appears to attempt to compare: a) the claimed computer network with the content servers 22 of *Birdwell*, b) the claimed first network with the data network 28 of *Birdwell*, and c) the claimed second network with the broadcast network 30 of *Birdwell*. To the best of Applicant’s understanding, the Action is also asserting that the clients 24 perform the claimed receiving and requesting steps. The Action’s comparison is summarized in the following annotated Fig. 1 of *Birdwell*:



Again, in *Birdwell*, clients 24 receive announcements and broadcasts but do not make any requests. (Col. 5, lines 8-14). The clients 24 do not request the claimed further information because there is no need for such a request. Instead, the clients 24 passively filter incoming data from broadcast network 30 at pre-scheduled times. The clients 24 do this passively because "[t]he clients are unable to reply or initiate communication to the broadcast center 26 using the broadcast network 30." (*Birdwell*, Fig. 1; col. 3, lines 26-31). Since the future broadcast will automatically occur at a pre-scheduled time, the clients 24 simply decide whether or not to tune into the broadcast transmission at that pre-scheduled time. (*Birdwell*, col. 5, lines 40-46). In other words, the broadcast transmission will occur regardless of any action that one of the clients might take. Each client simply decides whether or not it will listen to the broadcast.

In any event, *Birdwell* discloses that the announcements may be sent over the secondary link 32 or posted at a publicly accessible location on the network 28, such as at a Web site on the Internet. (*Birdwell*, col. 5, lines 58-67). However, this does not teach or suggest that the clients 24 (or any other device) send a request, over the secondary link 32, for further information based on the claimed received identifier.

Claim 1 is therefore allowable over the combination of *Herz* and *Birdwell* for at least the reasons discussed above. Dependent claims 2-8 are also allowable by virtue of depending from allowable independent claims, and further in view of the additional features recited therein.

Still further, even assuming, without admitting, that the combination of *Herz* and *Birdwell* does teach or suggest each and every feature of Applicants' claim 1, there is no proper motivation for combining the two references. Applicants contend that there is no motivation or suggestion to combine *Herz* with *Birdwell*.

The Action provides its motivation to combine stating, "[a]t the time the invention was made it would have been obvious to one in the ordinary skill in the art to incorporate requesting information based on received identifier via first or second network as disclosed by Birdwell in the method of receiving via a second network, unsolicited information in which unsolicited information is based upon user profile associated with the device in order to provide a more versatile and flexible way of targeting information to the users resulting in reliable multi-connectivity and consumer driven communications network." (Action, p. 3, emphasis added). Moreover, the purported motivation is a bare conclusion that has apparently been reached after having benefited from reading Applicants' own disclosure, and is thus impermissible hindsight. Applicants find no motivation to combine the references.

Applicants respectfully submit that there is no motivation or suggestion to combine *Herz* with *Birdwell*. Even assuming that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning, the Action provides no evidence that the combination takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, nor does the Action provide any evidence that the combination includes knowledge other than that gleaned from Applicants' disclosure. Applicants respectfully request the Examiner to provide such motivation. "[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." (*In re Kahn*, 441 F.3d 977, 988 (CA Fed. 2006)).

Claim 1 is therefore allowable over the combination of *Herz* and *Birdwell* for at least the reasons discussed above. Applicants' claims 2-8, 27-31, and 48, which depend on claim 1, are patentably distinct over the art of record for at least the same reasons as their ultimate base claim and further in view of the novel features recited therein.

Applicants' independent claim 9 recites similar features as described above with respect to Applicants' claim 1. Thus, for at least similar reasons as explained above with respect to

Applicants' claim 1, Applicants' claim 9 is patentably distinct over the combination of references.

Applicants' claims 10-21, 32-43, and 46-47, which depend on claim 9, are patentably distinct over the art of record for at least the same reasons as their ultimate base claim and further in view of the novel features recited therein.

**CONCLUSION**

All rejections having been addressed, Applicants respectfully submit that the instant application is in condition for allowance, and respectfully solicit prompt notification of the same. Should the Examiner find that a telephonic or personal interview would expedite passage to issue of the present application, the Examiner is encouraged to contact the undersigned attorney at the telephone number indicated below. If any additional required fees are or if an overpayment has been made the Commissioner is authorized to charge or credit Deposit Account No. 19-0733. Applicants look forward to passage to issue of the present application at the earliest convenience of the Office.

Respectfully submitted,  
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